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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,039	10/15/2001	Edward J. Kuebert	08049.0831	1583
22852	7590	08/21/2007	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			JABR, FADEY S	
		ART UNIT	PAPER NUMBER	
		3628		
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		08/21/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/976,039	KUEBERT ET AL.	
Examiner	<b>Art Unit</b>		
Fadey S. Jabr	3628		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 22 June 2007.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-30 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-30 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) Paper No(s)/Mail Date. \_\_\_\_ .  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_ . 5)  Notice of Informal Patent Application  
6)  Other: \_\_\_\_ .

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments with respect to claims **1, 2 and 11** have been considered but are moot in view of the new ground(s) of rejection.
2. Applicant's amendments filed 22 June 2007 with respect to the Objection of claim 1 has been fully considered and is therefore withdrawn.
3. Applicant's amendments filed 22 June 2007 with respect to the 35 U.S.C. 112, second paragraph, rejection has been fully considered and is therefore withdrawn.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims **1-3, 5, and 11-12** are rejected under 35 U.S.C. 102(e) as being anticipated by Morimoto, U.S. Patent No. 7,035,856 B1, hereinafter referred to as Morimoto.

As per **Claims 1, 3, 5 and 11-12**, Morimoto discloses a method and system for tracking and routing shipping items comprising:

- determining a first delivery point of the item (C. 14, lines 41-67);

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- notifying, based on the first delivery point, a recipient (sender) that the item is en route (C. 14, lines 41-67);
- allowing the sender to specify that the item is to be delivered to a second point (C. 14, lines 41-67);
- accepting at least one instruction designating a second delivery point (C. 14, lines 41-67); and
- delivering the item to the second delivery point (C. 14, lines 41-67).

As per **Claim 2**, Morimoto further discloses wherein accepting the at least one instruction comprises accepting at least one instruction from the recipient (C. 14, lines 41-67).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims **4, 6-10, 13, 16, 20 and 29** are rejected under 35 U.S.C. 103(a) as being unpatentable over Morimoto in view of Lopez, Pub. No. US2002/0029202 A1, hereinafter referred to as Lopez.

As per **Claim 4**, Morimoto discloses notifying the sender, if actual delivery is made (C.

14, lines 41-67). Morimoto fails to disclose requesting disposition instructions from the sender, if delivery was not made. However, Lopez teaches notifying the sender that the mailpiece has been forwarded (0013). Further, Lopez teaches when an item is undeliverable to either forward the address to the recipient's forwarding address, otherwise return the item to the sender (0035, 0040). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Morimoto and include allowing the sender to choose what to do with an item when it is undeliverable as taught by Lopez, because it allows the sender to be notified of the current status of a package in order to choose the correct course of action when the item is undeliverable.

As per **Claim 6-7, 13 and 16**, Morimoto discloses a method and system for tracking and routing shipping items comprising:

- changing a delivery point of the item while the item is en route (C. 14, lines 41-67);
- notifying a sender of the item (C. 14, lines 41-67).

Morimoto fails to disclose notifying the sender that the item is undeliverable, accepting a disposition instruction from the sender; and handling the item according to the disposition instruction. However, Lopez teaches notifying the sender that the mailpiece has been forwarded (0013). Further, Lopez teaches when an item is undeliverable to either forward the address to the recipient's forwarding address, otherwise return the item to the sender (0035, 0040). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Morimoto and include allowing the sender to choose what to do with an item when it is undeliverable as taught by Lopez, because it allows the sender to be

notified of the current status of a package in order to choose the correct course of action when the item is undeliverable.

As per **Claims 8-10**, Morimoto fails to disclose disposition instructions are to auction, donate or dispose of the item. However, Lopez discloses instructions for when the mailpiece is undeliverable, i.e. forwarding the mailpiece or returning the mailpiece to the sender (0035). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system Morimoto and include various instructions for handling an item when the item is undeliverable as taught by Lopez, because it allows a sender to ensure proper handling of a mailpiece, which is intended for a recipient. Further, it allows the carrier to arrange for other means of storing the mailpieces, which were not delivered to the intended recipient.

As per **Claims 20 and 29**, Morimoto fails to disclose requesting, from the sender, an approval of the second delivery point. However, Lopez teaches a return-to-sender determiner responsive to the sender return address indicator (0040). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Morimoto and include returning the mailpiece to the sender when the sender indicates return-to-sender service as taught by Lopez, because it allows the sender to be notified of the current status of the recipient's address when sending future mailpieces.

8. Claims 14-15, 17-19, 21-22, 25 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morimoto in view of Barta et al., U.S. Patent No. 6,634,551 B2, hereinafter referred to as Barta.

As per Claims 14, 28 and 30, Morimoto discloses a method and system for tracking and routing shipping items comprising:

- determining a first delivery point of the item (C. 14, lines 41-67);
- providing a notification to indicate that the item is en route to the first delivery point (C. 14, lines 41-67);
- accepting a second delivery point of the item (C. 14, lines 41-67); and
- delivering the item to the first delivery point and second delivery point based on the conditional acceptance of the second delivery point (C. 14, lines 41-67).

Morimoto fails to *explicitly* disclose *conditionally* accepting a second delivery point. However, Barta teaches providing delivery notices to recipients of packages where an alternate address for the package can be provided given that the recipient is authenticated using the delivery notice information (C. 6, line 67 – C. 7, line 38). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Morimoto and include delivering the package to an alternate address once the recipient information is authenticated as taught by Barta, because it prevents users not associated with the delivery notice from modifying the package destination.

As per **Claims 15**, Morimoto discloses providing information to indicate that the item was delivered to the one of the first delivery point and second delivery point (C. 14, lines 41-67).

As per **Claims 17-18**, Morimoto fails to *explicitly* disclose accepting at least *one additional* delivery point for the item; and delivering the item to the at least one *additional* delivery point; and providing at least one *additional* notification based on delivery of the item to the at least one additional delivery point. However, Morimoto discloses accepting an alternate delivery point and delivering the item to that alternate delivery point (C. 14, lines 41-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Morimoto and include accepting any number of delivery points and any number of notifications to the recipient, because it allows the delivery service to ensure proper delivery of the mailpiece to a deliverable recipient location.

As per **Claim 19**, Morimoto discloses capturing an image of the item (C. 13, line 60 - C. 14, line 10).

As per **Claim 21**, Morimoto discloses determining at least one characteristic of the item (C. 3, lines 21-24, C. 12, lines 44-46).

As per **Claim 22 and 25**, Morimoto discloses providing the notification to indicate that the item is en route to the first delivery point includes information indicating the at least one characteristic of the item (C. 3, lines 21-24, C. 12, lines 44-46, C. 14, lines 41-67).

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9. Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morimoto in view of Barta as applied to claim 14 above, and further in view of Kadaba, U.S. Patent No. 6,539,360 B1, hereinafter referred to as Kadaba.

As per Claims 23-24, Morimoto fails to *explicitly* disclose characteristics of the item comprises determining a size of the item. However, Morimoto discloses a scale for determining the weight of the package (C. 3, lines 21-24). Moreover, Kadaba teaches a package level detail notification transmitted to the carrier, or consignor or consignee which includes tracking number, item description, package weight, rate codes, special handling requirements and other pertinent information (C. 7, lines 3-15). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Morimoto and include determining various common package characteristics as taught by Kadaba, because it allows the system to provide the recipient with various common characteristics.

10. Claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morimoto in view of Barta as applied to claim 14 above, and further in view of Jones, Pub. No. US2003/0233190 A1, hereinafter referred to as Jones.

As per Claims 26-27, Morimoto fails to disclose wherein providing the notification to indicate the item is en route to the first delivery point comprises providing information to indicate a time the item will arrive at the first delivery point. However, Jones teaches informing a user when the delivery vehicle is a particular time away from their residence,

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and also allowing the recipient to enter the amount of time to be notified of the package delivery (0008, 0095). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Morimoto and include informing the recipient of the time the mailpiece will arrive as taught by Jones, because it allows a recipient to adjust his/her schedule and avoid arrive too early or too late.

### ***Conclusion***

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fadey S. Jabr whose telephone number is (571) 272-1516. The examiner can normally be reached on Mon. - Fri. 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fadey S Jabr  
Examiner  
Art Unit 3628

FSJ

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Hand delivered responses should be brought to the Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314

  
JOHN W. HAYES  
SUPERVISORY PATENT EXAMINER